

REMARKS

The final Office Action dated April 29, 2008, has been carefully considered. Claims 30-35 are pending in the present application. Claim 30, the only independent claim, has been amended to define more clearly a certain embodiment of the present invention. Support for this amendment can be found in the originally-filed specification at, for example, page 5, line 31. No new matter has been introduced. Favorable reconsideration is requested.

I. CLAIM REJECTION UNDER § 103(a)

Claims 30-35 have been rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over European Patent No. EP 0689807 to Turnlund *et al.* (“Turnlund”) in view of European Patent No. EP 0842729 to Lashinski (“Lashinski”).¹ This rejection is respectfully traversed.

Claim 30 recites, *inter alia*, ablating the coated structure with an ultrashort-pulse laser to form at least one opening extending through the coated portion. Claims 31-35 depend from claim 30 and, thus, include all the recitations of claim 30.

In rejecting claims 30-35, the Examiner agrees that Turnlund does not disclose or suggest using an ultrashort-pulse laser to ablate medical device comprising a metal. Turnlund is directed to biodegradable mesh-and-film stents that are constructed of biodegradable materials (Abstract). Turnlund does not disclose or suggest a medical device comprising a metal. Also, Turnlund, at column 9, lines 47-50, uses a continuous CO₂ laser, a pulsed YAG laser, or an excimer laser for cutting the mesh-and-film material. Turnlund does not disclose or suggest the use of an ultrashort-pulse laser.

The Examiner cites Lashinski as remedying the deficiencies of Turnlund. Applicant respectfully disagrees. Lashinski, relates to a method of forming an intravascular device, such as a stent, without creating shock or thermal stress affected areas to or in the final product (Abstract). Lashinski uses an ultrashort-pulse laser to create the intravascular device. However, Lashinski does not disclose or suggest ablating a *coated structure* with an ultrashort-pulse laser to form at least one opening extending through the coated portion, as recited in claim 30 (emphasis added). Lashinski also does not disclose a coating comprising a biologically active

¹ Applicant notes that, in rejecting claims 30-35, the Examiner identifies U.S. Patent No. 6,471,721 to Dang but discusses Lashinski without mentioning Dang. Applicant, therefore, presumes that claims 30-35 are rejected under Section 103(a) as being unpatentable over Turnlund in view of Lashinski.

material to be released from the coating. Lashinski is completely silent with respect to ablating a medical device having a *coated* portion on its surface. As discussed at column 6, lines 24-46 of Lashinski, adjustments to the pulse duration and frequency is required to cut through metals, such as stainless steel so as to compensate for the metals thermal properties. Lashinski is silent with respect to cutting through a coating layer comprising a biologically active material.

Furthermore, Applicant asserts that it is improper to combine Turnlund and Lashinski. Turnlund relates to biodegradable mesh stents reinforced with a biodegradable film laminate and does not disclose or suggest that such medical device can comprise a metal, such as stainless steel. One skilled in the art would not combine Turnlund and Lashinski to obtain the presently claimed invention.

According to MPEP § 2113, “[t]he structure implied by the process steps should be considered when assessing the patentability of product-by-process claims over the prior art, especially where . . . the manufacturing process steps would be expected to impart distinctive structural characteristics to the final product.” The resultant medical device of a combination of Turnlund and Lashinski, if such combination were proper (which Applicant believes is not), would not be the same as the presently claimed device. *See, e.g.*, present specification, page 3, lines 12-34. Also, Turnlund and Lashinski do not disclose or suggest a medical device that is manufactured by (a) obtaining a *metal* structure having the first surface and the second surface; (b) coating at least a portion of the first surface with a first coating material; and (c) ablating the *coated* structure with an ultrashort-pulse laser to form at least one opening extending through the coated portion, as required by the present claims (emphasis added). Lashinski does not disclose a laser-ablated opening extending through a coated portion, or a medical device that is formed by first coating a structure.


For at least the above reasons, Applicant believes that the combination of Turnlund and Lashinski would not result in the medical device of the presently claimed invention. Thus, it is believed that claims 30-35 are patentable over Turnlund in view of Lashinski, and withdrawal of the rejection under 35 U.S.C. § 103(a) is respectfully requested.

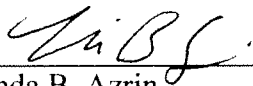
II. CONCLUSION

This Amendment is believed to place this application in condition for allowance and, therefore, its entry is believed proper under 37 C.F.R. § 1.116. Accordingly, entry of this Amendment, as an earnest effort to advance prosecution and reduce the number of issues, is respectfully requested. Should the Examiner believe that issues remain outstanding, it is respectfully requested that the Examiner contact Applicant's undersigned attorney in an effort to resolve such issues and advance the case to issue.

Respectfully submitted,

Date: June 25, 2008


Gidon D. Stern (Reg. No. 27,469)

By: 
Linda B. Azrin (Reg. No. 44,516)
JONES DAY
222 East 41st Street
New York, New York 10017
(212) 326-3939